

### **REMARKS**

In response to the final Official Action of November 17, 2006, claims 17, 19, 20 and 25 have been amended in a manner which is believed to particularly point out and distinctly claim the invention. Correction of a typographical error at page 5 of the specification has been made. No new matter is presented. Reconsideration of the rejection of all of the claims is respectfully requested for the reasons presented below.

More particularly, claim 17 has been amended to incorporate features found in the amulet presented in claim 1; namely, a microphone and an electroacoustic transducer for setting up an audio interface with a user of the amulet, as well as a transceiver for establishing a communication between the microphone and electroacoustic transducer and the personal communication device and for receiving information to be presented in said display from another part of the personal communication device. Support for this amendment is found in the application as originally filed, including Figures 4a and 4b and the accompanying description at page 8, lines 16-33. Corresponding amendment has been made to claim 25, which is similar to claim 17 but written using means plus function terminology. Amendment to claims 19 and 20 is made for consistency with the amendment to claim 17.

Claims 1-6, 8-18 and 22-26 are rejected under 35 USC §103(a) as being unpatentable over US patent 6,825,830, Kanesaka et al (hereinafter Kanesaka), in view of US patent application publication 2002/0095538, Marshall. The Office asserts that Kanesaka teaches all of the claims features except to teach that the amulet comprises a microphone and a speaker. The Office asserts that Marshall teaches such features as shown in Figure 8 thereof and therefore it would be obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Marshall in view of Kanesaka in order to record or retrieve information in the memory as suggested by Marshall. Applicant respectfully disagrees for the reasons presented in the arguments filed on September 11, 2006, as well as for the reasons presented below.

With respect to the personal telecommunication device recited in claim 1, a key feature is that the amulet not only comprises a display and a hanging arrangement for allowing the amulet to be worn on the torso of a human user, but that it further incorporates a microphone and an electroacoustic transducer for setting up an audio interface between the personal communication device and a human user. It is important to note that such a personal telecommunication device such as shown in Figures 4a and 4b places the microphone and the electroacoustic transducer in the amulet which is separate from the claimed first part which comprises a keypad for allowing a human user to input information to the personal communication device. Traditionally, such as shown in Kanesaka, the keypad of a telecommunication device is associated with a display (110), a microphone (205) and an electroacoustic transducer (speaker) (204) in a single structural part, such as portable telephone (100) shown in Figures 1 and 2 of Kanesaka. The second part of Kanesaka (101) is separate from the first part and basically comprises an auxiliary display screen (120).

Thus, the portable telephone part of Kanesaka is the part that is placed by the user's ear and mouth in order to communicate. The auxiliary display (120) can display second level information corresponding to a sub-level of the first level of information displayed on the main display (110) (see Abstract of Kanesaka). The purpose for this auxiliary display is discussed in Kanesaka at column 1, lines 27-36 and, in particular, is to solve the problem of allowing telephone numbers and other information stored in the portable telephone (that is the first unit) to be displayed on the secondary display while a conversation is taking place which would make viewing of the display (110) on the portable telephone impossible due to its placement of the portable telephone next to the user's head when the telephone is in use.

The present invention provides a totally different concept from what is disclosed in Kanesaka. In particular, the present invention is directed to the concept of an amulet with a hanging arrangement (104) which is designed to be worn by a user. The amulet is separate from a second part which includes a keypad. An underlying principle of the

present invention is that the amulet comprises a display as well as an audio interface. The amulet is worn by the user and not placed next to the user's head when the device is in use for communicating. The second part, which includes a keypad part, is designed to communicate with the amulet but is physically separate from the amulet. The overall concept of the present invention is that the amulet is a wearable object which has a display and the microphone and electroacoustic transducer necessary for establishing an overall personal telecommunication device in cooperation with the keypad part of the present invention. The keypad part would not be placed next to the user's head during use since it is the amulet which is worn that includes the audio user interface which picks up the user's speech and which has a electroacoustic transducer for presenting audible information to the user when the personal communication device is in use.

With this concept in mind, it is respectfully submitted that the arguments presented by the Office to reject the claims, including claim 1, on the basis of Kanesaka in combination with Marshall are incorrect. The Office argues that applicant's previous arguments against combining Kanesaka and Marshall misapply the law with respect to combination of references. Applicant respectfully disagrees for the simple reason that if one has a device as disclosed in Kanesaka which is a portable telephone with a separate auxiliary display, what would be the motivation to take that auxiliary display and put into it a microphone and an electroacoustic transducer for setting up an audio interface between this auxiliary display and the portable telephone when, in fact, the portable telephone by its very nature has a microphone and a speaker. This is clearly shown in Kanesaka in Figures 1 and 2 which show a portable telephone (100) having a keypad (switches) (206), a speaker (204), a microphone (205) and a display (110). To put the microphone and speaker into the auxiliary display (120) would be totally contrary to the purpose of the auxiliary display as discussed in Kanesaka; namely, to provide a display for information to the user while the portable telephone is in use by the user which effectively makes viewing of the information on the primary display (110) impossible because the portable telephone (100) is next to the user's head.

The Office asserts that Marshall, by showing a module (10) which can be worn around a user's neck and which includes a microphone and speaker, makes up for the deficiencies in Kanesaka and could therefore be combined with Kanesaka to suggest the present invention. But to do so, one must modify Kanesaka in a manner which is totally against the very purpose of Kanesaka; that is, to provide an auxiliary display to show information to the user while the portable telephone is in use. Kanesaka does not disclose, suggest or intimate anything with respect to separating the microphone and speaker from the portable telephone (100), where it logically resides, into an auxiliary display. Furthermore, the auxiliary display is not intended to be worn by the user.

In short, what would be the motivation for taking the microphone and speaker in the portable telephone (100) shown in Kanesaka and move it to the auxiliary display? There is no particular reason why the device in Kanesaka would suggest such a departure from the normal functioning of the portable telephone disclosed in Kanesaka. In summary, there is no reason and no motivation whatsoever for so modifying the device taught by Kanesaka.

Marshall in no way makes up for the motivational deficiency in Kanesaka. The entertainment library (30) as disclosed in Marshall is preferably available at a shopping center, airport or other public venue and holds in its memory (32) a large selection of books, music, movies and/or other entertainment media in an electronically readable format for purchase via use of a portable module (10) (see Figure 1 and paragraph 29 of Marshall). The entertainment library is clearly not a portable device but is simply a repository for various entertainment media for purchase by a user. The portable information storage module (10) has nothing to do with a personal telecommunication device as disclosed and claimed in the present invention nor does it have anything to do with the portable telephone and auxiliary display disclosed in Kanesaka.

The fact that Marshall shows a portable module (10) that can store entertainment information, has absolutely nothing to do with a personal telecommunication device nor would it in any way suggest modification of the auxiliary display shown in Kanesaka so

as to put a microphone and speaker in that auxiliary display in a manner which has nothing to do with the purpose of that auxiliary display and, in fact, which would make the overall device disclosed in Kanesaka contrary to its very purpose; that is, for the portable telephone to be the device used by the user for telecommunication purposes and the auxiliary display used for presenting information concerning telephone numbers and the like to the user while the portable telephone is in use (i.e. adjacent to the user's head).

As discussed at length in applicant's "Remarks" in the response filed on September 11, 2006, MPEP §2141.01, Section V specifically states that if the proposed modification (that is to put a microphone and speaker into the auxiliary display shown in Kanesaka) would render the prior art invention being modified unsatisfactorily for its intended purpose (to allow personal communication by the portable telephone 100) then there is no suggestion or motivation to make the proposed modification. Here, as set forth in applicant's prior remarks, to modify Kanesaka in the manner as suggested by the Office so as to place a microphone and speaker in the second information processing device (auxiliary display) would be contrary to the very purpose of Kanesaka, which is to have the first information processing device (portable telephone) to be placed near the user's head when in use so as to allow communication which therefore requires the microphone and speaker to be in the portable telephone. There would be absolutely no motivation to put a speaker and a microphone into the auxiliary display because it would at least be totally redundant with the speaker and microphone in the portable telephone.

#### **Further Observations Concerning the Art**

The concept of a media player in combination with a personal communication device has already been achieved in the art since the marketplace abounds with high end telephones which include media capability such as built-in MP3 players. In these devices, a single hand-held unit is used by the user which invariably is placed against

the side of the user's head when the device is used for telecommunication purposes. Alternatively, such a device can include a small earpiece plugged into the device with the earpiece placed adjacent to user's ear. In all of these configurations, the telecommunication devices that include media has a keyboard, display, microphone and/or loudspeaker in the same single mechanical unit completely contrary to the claimed invention herein.

In addition, there are physiological differences between the personal telephone device disclosed in Kanesaka and the media device disclosed in Marshall. In particular, telephone devices with displays like that of Kanesaka depend on using the user's eyes, mouth and ears simultaneously; that is, the mouth and ears are used for voice communication and the auxiliary display is used by the user's eye to view information while the portable telephone is in use. The device must comprise hardware for bringing a speaker close to the user's ear and a microphone close to the user's mouth and a display which can be in the field of view. Music players, like that of Marshall, are primarily for use with a user's ears and possibly the user's eyes. Since it has been common practice for ages to plug a connecting cable of a small earpiece to the main body of a music player, there never was and still is no motivation to separate and break apart the main body of a music player into additional parts. Thus, it would be implausible to combine Kanesaka and Marshall.

## **Conclusion**

For all of the foregoing reasons, it is respectfully submitted that applicant has clearly shown that there would be no motivation to combine Kanesaka and Marshall in the way suggested by the Office at paragraph 3 of the Official Action.

Contrary to the position asserted at paragraph 1 of the final Official Action, applicant is not attacking the individual merits of Kanesaka and Marshall, but rather is posing the fundamental question when an obviousness rejection is made; namely, what

does a secondary reference teach one of ordinary skill in the portable telephone art which would motivate the modification in the structure of the primary reference to arrive at the claimed invention.

In the present situation, the portable telephone disclosed in Kanesaka with its auxiliary display has a very clear purpose; namely, to present auxiliary information to the user while the portable telephone is in use and therefore preventing the user from seeing the primary display (110). Marshall simply discloses the idea that a portable module can be used for downloading information from an entertainment library (30) such as found in a shopping center so as to allow the user to listen and/or view downloaded entertainment.

Thus, even if the art disclosed in Marshall is in any way relevant to the portable telephone disclosed in Kanesaka, it would not, even if combined, give rise to the present invention since it would require modification of Kanesaka against its very purpose. Therefore, claim 1 is not suggested by Kanesaka in view of Marshall.

Claim 17 has been amended to particularly point out and claim that the amulet part for a personal telecommunication device includes a microphone and an electroacoustic transducer for setting up an audio interface with a user of the amulet and that a transceiver is for establishing a communication between the microphone and electroacoustic transducer and the personal telecommunication device and for receiving information to be presented in the display.

For the same reasons as presented with respect to claim 1, there is no suggestion in Kanesaka for modifying its auxiliary display to include a microphone and an electroacoustic transducer for setting up an audio interface with a user of the amulet nor is there any suggestion that there be a transceiver for establishing a communication between the microphone and electroacoustic transducer and the personal telecommunication device. Again, to modify the auxiliary display in Kanesaka to include the microphone, electroacoustic transducer and an associated transceiver would be

totally contrary to the very purpose of Kanesaka. It is therefore respectfully submitted that claim 17, as amended, is not suggested by Kanesaka in view of Marshall.

Claim 23 is similar to claim 1 and is directed to a personal telecommunication device. The elements recited therein include elements presented in means plus function format but otherwise are similar to the elements recited in claim 1. For reasons similar to those presented above with respect to claim 1, claim 23 is also not suggested by Kanesaka in view of Marshall.

Amended claim 25 is directed to an amulet part for a personal telecommunication device and comprises elements similar to those presented in claim 17 but written using means plus function format. For similar reasons to those presented above with respect to claim 17, claim 25 is not suggested by Kanesaka in view of Marshall.

Since each of the independent claims of the present invention are believed to be distinguished over the cited art, it is respectfully submitted that all of the dependent claims are further distinguished over the cited art and therefore the rejection of dependent claims 2-6, 8-16, 18, 22, 24 and 26 at paragraph 3 of the Official Action, the rejection of claim 7 at paragraph 4 of the Official Action, and the rejection of claims 19-21 at paragraph 5 of the Official Action are respectfully overcome. Please note that claims 19 and 20 have been amended in view of the amendment to independent claim 17.

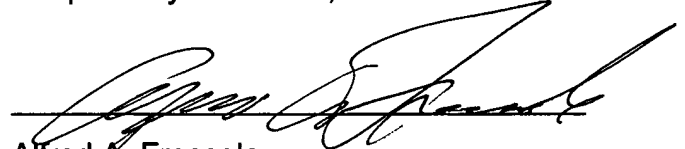


In view of the foregoing, it is respectfully submitted that the present application as amended is in condition for allowance and such action is earnestly solicited.

Respectfully submitted,

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WARE, FRESSOLA, VAN DER SLUYS  
& ADOLPHSON LL  
Bradford Green, Building Five  
755 Main Street, P.O. Box 224  
Monroe, CT 06468  
Telephone: (203) 261-1234  
Facsimile: (203) 261-5676  
USPTO Customer No. 004955

A handwritten signature in black ink, appearing to read 'Alfred A. Fressola', is written over a horizontal line.

Alfred A. Fressola  
Attorney for Applicant  
Registration No. 27,550